## REMARKS

Responsive to the Office Action mailed August 7, 2006, Applicants provide the following. Claims 2, 15, 17 and 20 were previously canceled. Seventeen (17) claims remain pending in the application: Claims 1, 3-14, 16, 18, 19 and 21. Reconsideration of claims 1, 3-14, 16, 18, 19 and 21 in view of the remarks below is respectfully requested.

By way of this amendment, Applicants have made a diligent effort to place the claims in condition for allowance. However, should there remain any outstanding issues that require adverse action, it is respectfully requested that the Examiner telephone the undersigned at (858) 552-1311 so that such issues may be resolved as expeditiously as possible.

### Claim Rejections - 35 U.S.C. §103

1.      Claims 1, 4-8, 16, 19 and 21 stand rejected under 35 U.S.C. § 103(a), as being unpatentable over U.S. Patent Publication No. 6,701,441 (Balasubramaniam et al.) in view of U.S. Patent Publication No 2004/0236843 (Wing et al.). Applicants respectfully traverse these rejections.

The applied combination fails to teach each limitation as recited in at least claim 1, and thus, fails to establish a prime facie case of obviousness at least with respect to claim 1. More specifically, the Balasubramaniam and Wing references fail to teach at least "determining whether the electronic device comprises a diagnostic controller," as recited in claim 1. The office action suggests that this limitation is taught by the Balasubramaniam patent citing reference numerals 408 and 414 of FIG. 4-1, and column 11, lines 8-31 (Office Action, pg. 3). However, the system described in the Balasubramaniam patent at least does not teach or suggest determining whether an electronic device comprises a controller. Instead, in the system described in Balasubramaniam "the CGI program running on the server computer causes a web page to be downloaded to the user computer 104. Embedded in the web page are Active X# controls" (Balasubramaniam, col. 11, lns. 8-10, emphasis added). The office action equates the Active X controls to the controller recited in claim 1 (i.e., "the ActiveX control corresponds to a diagnostic controller" (Office Action, pg. 3, lns. 16-17). As such, Balasubramaniam causes a web page with embedded Active X controls to be downloaded to the user computer 104 without

any prior determination of whether the user computer already comprises the Active X controls (see, Balasubramaniam, col. 11, lns. 8-14). Therefore, the Balasubramaniam patent does not teach or suggest "determining whether electronic device comprises a diagnostic controller," as recited in claim 1, and instead specifically teaches away from such a determination in that the Balasubramaniam describes that Active X controls are automatically downloaded without making a determination of whether the Active X controls are present.

The Wing reference also fails to teach at least determining whether the electronic device comprises a diagnostic controller as stated by the Examiner in a previous Office Action (see for example, Office Action mailed February 21, 2006, pg. 5). To establish a *prime facie* case of obviousness "the prior art reference (or references when combined) must teach or suggest all the claim limitations" (MPEP §1243). As such, a *prima facie* case of obviousness has not been established because the applied combination of references fails to teach all the claim limitations of claim 1, and thus, claim 1 is not obvious in view of the applied references.

Similarly, claim 16 recites in part "means for determining whether the electronic device comprises a diagnostic controller". As such, claim 16 is also not rendered obvious by the Balasubramaniam and Wing combination at least for the reasons described with respect to claim 1, and therefore, is in condition for allowance.

Further, dependent claims 4-8 that depend from amended claim 1, and dependent claims 19 and 21 that depend from claim 16 are also not obvious over the applied references at least due to their dependence on allowable claims 1 and 16.

Additionally, with respect to at least claim 4, the combination of Balasubramaniam and Wing fails to teach at least remotely receiving the diagnostic controller over the distributed network prior to the identifying the electronic device. The office action suggests that Balasubramaniam describes identifying the electronic device as recited through the "registering" described in Balasubramaniam. However, the registering of the user computer occurs before scripts with ActiveX controls, which the office action equates with the controller, are received by the user computer (see FIG. 4). More specifically, the Balasubramaniam patent describes receiving a registration from a user with respect to steps 402-404 of FIG. 4, stating that "[t]his process, of authenticating the user computer 104 and creating a secured connection

between the two computers 100 and 104, is called 'registering' the user computer 104" (col. 10, lns. 54-57, emphasis added). The Balasubramaniam patent continues describing the process following the "registration" of the user such that Active X controls are sent to the user computer in step 408 of FIG. 4. As such, the Balasubramaniam patent does not teach at least "remotely receiving the diagnostic controller over the distributed network prior to the identifying the electronic device" as recited in claim 4. The Wing reference also fails to teach "remotely receiving the diagnostic controller over the distributed network prior to the identifying the electronic device". Thus, claim 4 is not obvious in view of the combination of Balasubramaniam and Wing references as the combination fails to teach each limitation as recited, and thus, claim 4 is in condition for allowance.

2.      Claims 3 and 18 stand rejected under 35 U.S.C. § 103(a), as being unpatentable over the Balasubramaniam patent in view of the Wing reference in further view of U.S. Patent No. 6,880,083 (Korn). Applicants respectfully traverse these rejections as the combination of references fails to teach each limitation of at least claims 3 and 18, and thus, a *prima facie* case of obviousness had not been established. Specifically, Applicants have demonstrated that the Balasubramaniam and Wing references fail to teach each limitation of claims 1 and 16. Claims 3 and 18 depend from claims 1 and 16, respectively. The Korn patent also fails to teach or suggest at least those limitations identified above as not taught by Balasubramaniam or Wing. Therefore, claims 3 and 18 are also not obvious over the applied combination of references.

Further, Applicants respectfully submit that one skilled in the art would not combine the encryption capability described in the Korn patent with the system described in the Balasubramaniam reference because there is no motivation for the combination. The Balasubramaniam reference already provides "a method to verify a downloaded software object so that the software object is executed only if it is downloaded by an authorized entity," and does so by first determining "the URL to which a browser running on the client computer is pointed and enables the downloaded software program only if the URL to which the browser is pointed is an authorized URL" (Balasubramaniam, col. 8, lns. 16-19). Therefore, there would be no

motivation to incorporate the encryption capability of the Korn patent into the Balasubramaniam patent. As such, the combination of references does not render claims 3 and 18 obvious, and thus, claims 3 and 18 are in condition for allowance.

3.     Claims 9-14 stand rejected under 35 U.S.C. § 103(a), as being unpatentable over the Balasubramaniam patent in view of the Wing reference in further view of U.S. Publication No. 2002/0165952 (Sewell). Applicants respectfully traverse these rejections.

The combination of the Balasubramaniam, Wing and Swell references fails to establish a *prime facie* case of obviousness at least with regard to claim 12, because the combination fails to teach each limitation as recited in claim 12 and would not result in a system as recited in claim 12. Claim 12 recites in part "a remote diagnostic controller ... receives the web page and implement the at least one script ... the remote diagnostic controller is further configured to receive a first reply from the electronic device and to forward a second and/or subsequent instructions to the electronic device based on the first reply and/or previous replies." The office action specifically states that the Balasubramaniam patent does not teach receiving a first reply or submitting further instructions based on previous replies and relies on the Wing reference (office action, pg. 9). The Wing reference, however, does not teach at least a diagnostic controller which receives a first reply from the electronic device and forwards a second and/or subsequent instruction to the electronic device based on the first reply and/or previous replies. Instead, the Wing patent describes a system where "[a] client application is ... downloaded from the server to the computer ... the results obtained from executing the client scripts or individual commands are returned to the diagnosing server ... and a disposition is returned to the browser of the computer" (Wing, para. 0009). Therefore, the entity which receives and executes the scripts is not the same as the entity which returns further instructions based on a first reply.

Further, the Swell reference also fails to teach or suggest at least a remote diagnostic controller configured to receive a first reply from the electronic device and to forward a second and/or subsequent instructions to the electronic device based on the first reply and/or previous replies. Therefore, the combination of applied references fails to teach each limitation

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as recited in claim 12, and thus, claim 12 is not obvious in view of the combination of the Balasubramaniam, Wing and Swell references.

Claims 13 and 14 depend from claim 12 and are not obvious over the applied references at least due to their dependency on allowable claim 12.

Claims 9-11 depend from claim 1. As described above the Balasubramaniam and Wing reference fails to teach each limitation as recited in claim 1. The Swell reference also fails to teach at least determining whether the electronic device comprises a diagnostic controller. As such, claim 9-11 are not obvious in view of the Balasubramaniam, Wing, and Swell references, and thus, are in condition for allowance.
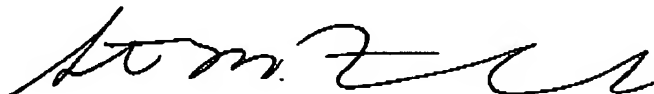
## CONCLUSION

Applicants submit that the above remarks place the pending claims in a condition for allowance. Therefore, a Notice of Allowance is respectfully requested.

Respectfully submitted,

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